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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,540	12/03/2003	George W. McClurg	1823.0820007	3199

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EXAMINER

TUCKER, WESLEY J

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,540

Applicant(s)

MCCLURG ET AL.

Examiner

Wes Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :8-19-04, 9-20-04, 9-29-05, 3-20-06, 9-20-06.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, are drawn to a non-planar prism for scanning a finger/palm-print, classified in class 382, subclass 127.
- II. Claims 16-25, are drawn to obtaining calibration data for a finger/palm-print scanner, classified in class 382, subclass 125.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as obtaining image and calibration data for calibrating the image sensor. This is separate from the utility of subcombination of group I, which appears to only capture finger/palm-print data with no intention of calibrating the image sensor. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a

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continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Applicant's election without traverse of group II of claims 16-25 in the telephone interview conducted on October 11, 2006 with Jason Eisenberg Reg. No. 43,447 is acknowledged. Accordingly Claims 1-15 are withdrawn and the elected Claims 16-25 are examined below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 uses the language "capturing an image representing a print pattern of a person interacting with a non-planar platen of a prism." It should be clear from the claims and the specification that image data is captured of a hand/palm/fingerprint. The claims should be amended to clarify this. Image data is not captured of "a print pattern of a person." That could be interpreted as any body part or even internal organ can rest on the imaging device. Print pattern could be a cardboard cutout of the person or a

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picture of the person. The language is exceedingly vague and indefinite. The claim should be amended to accurately describe the operation being performed. Appropriate correction is required to place the claims in the scope of the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent 5,528,355 to Maase et al. and U.S. Patent 6,658,164 to Irving et al.

With regard to claim 16, Irving discloses a method comprising:

- (a) capturing an image representing a print pattern of a person interacting with a platen of a prism (column 3, lines 55-65 and column 4, lines 1-9));
- (b) capturing calibration data (column 4, lines 56-67);
- (c) generating image information including both the captured image and the captured calibration data (column 4, lines 56-67); and

(d) storing the image information (column 4, lines 56-67).

Irving does not explicitly disclose that the prism is non-planar, but does suggest that the platen "can include, but is not limited to, an optical prism, set of prisms, or set of micro-prisms" (column 4, lines 6-9).

Maase discloses a non-planar prism for the purposes of better conforming to the natural contour of a human hand (Fig. 1). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use a non-planar prism as taught by Maase in combination with the calibration scanning of Irving in order to enable a prism surface that better conforms to a user's hand.

With regard to claim 17, the combination of Irving and Maase discloses the method of claim 16, and Maase discloses wherein step (a) comprises capturing a palm print pattern (Fig. 2A). Irving also suggests a palm print (column 3, lines 60-65).

With regard to claim 18, the combination of Irving and Maase discloses the method of claim 16, and Irving discloses wherein step (a) comprises capturing a fingerprint pattern (column 3, lines 60-65). Maase also discloses fingerprints (Fig. 1A).

With regard to claim 19, the combination of Irving and Maase discloses the method of claim 16, and Irving discloses wherein step (a) comprises capturing a palm print pattern and a fingerprint pattern (column 3, lines 60-65). Maase also discloses both fingerprint and palm print (Fig. 1A).

With regard to claim 20, the combination of Irving and Maase discloses the method of claim 16, and Irving discloses wherein step (a) comprises capturing a hand print pattern (column 3, lines 60-65).

With regard to claim 21, the combination of Irving and Maase discloses the method of claim 16, and Irving discloses wherein step (b) comprises capturing a calibration target associated with the prism (column 4, lines 56-67).

With regard to claim 22, the combination of Irving and Maase discloses the method of claim 16, and Irving discloses further comprising: (e) using the calibration data in the image information during subsequent displaying of the image, such that the image is properly displayed (column 7, lines 1-40). Irving discloses using the calibration target to determine correction coefficients to apply to the pixels in the image accordingly.

With regard to claim 23 the combination of Irving and Maase discloses the method of claim 16, and Irving further discloses further comprising: (e) using the calibration data to determine a quality of the image (column 8, lines 53-59).

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With regard to claim 24, the combination of Irving and Maase discloses the method of claim 16, and Irving discloses wherein steps (a) and (b) are performed simultaneously (column 4, lines 1-10 and lines 35-54).

With regard to claim 25, the combination of Irving and Maase discloses the method of claim 16, and Irving discloses wherein steps (a) through (d) are performed a predetermined number of times to capture a series of images (Fig. 16).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wes Tucker whose telephone number is 571-272-7427. The examiner can normally be reached on 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-2214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Wes Tucker

10-10-06


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